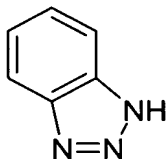


## REMARKS

The Examiner issued a restriction requirement under 35 U.S.C. §§ 121 and 372. The Examiner believes that Claims 1-29 and 34-46 are drawn to more than one inventive concept (as defined by PCT Rule 13), and thus a restriction is required under PCT Rule 13.2. The Examiner recited Annex B, Part 1(b) and (e) in support of the Examiner's belief that a restriction requirement is appropriate.

The Examiner also cited 37 C.F.R. § 1.475(a) in support of the Examiner's argument that a restriction is appropriate. 37 C.F.R. § 1.475 describes unity of invention requirements for inventions before the International Searching Authority, the International Preliminary Examination Authority and during national stage.

The Examiner argues that the "technical feature" of the present invention is



and that it fails to define a contribution over the compound that is described in Aldrich Catalog, 2005-2006, 280.

The Examiner also considered that the compounds claimed were too many, with too many variables, and vastly different compounds. The Examiner felt that the search for these various compounds would be a serious burden.

The Applicants respectfully traverse the restriction requirement on the following grounds.

First, the Applicants believe that the "core structure" or "technical feature" of the claimed compounds is not limited to the substituted double ring structure. The Applicants believe that the carbon, nitrogen chain attached to the double ring structure should be included. This chain contains the bi-substituted carbon ( $C_a$ ) where "a" is 1, 2 or 3; and a distinct carbon atom with a cyano moiety attached; then the bi-substituted nitrogen atom. The Applicants' note that their invention contains at least two carbon atoms between the nitrogen on the ring and the nitrogen atom in the side chain. The Applicants believe that this side chain can and should be considered part of the Applicants' "core structure" or "technical feature".

Second, because the number of carbon atoms between the nitrogen on the ring and the nitrogen in the side chain is limited to two, three or four ( $C_a$  where  $a = 1, 2, \text{ or } 3$ ; + the distinct carbon with the cyano moiety), the Applicants believe that there are not an unlimited number of

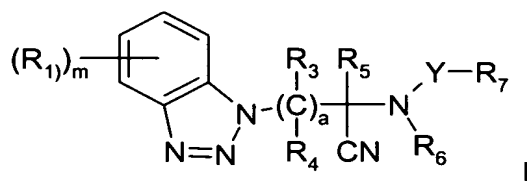
compounds for the Examiner to search and that the search would not cause an undue burden on the Examiner, especially if the Examiner uses the carbon – nitrogen chain as the basis for the search.

Third, the Applicants kindly point out that the groups of claims, as defined by the Examiner, meet the requirements set forth of 37 C.F.R. § 1.475(b) and PCT Rule Annex B, Part 1(b). According to 37 C.F.R. § 1.475(b),

[a]n international or national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories: ...

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product, ....

The group of claims as set forth by the Examiner fulfill the requirements of 37 C.F.R. § 1.475(b)(3). They relate to a product, the process for manufacturing the product, and the use of the product. The product in this case are the genus of compounds with the general structure of formula I as defined in Claim 1, namely:



Finally, it is noted that the International Searching Authority and the International Preliminary Examining Authority did not consider that the pending claims in the PCT application as lacking unity. The Applicants amended the PCT claims to bring them more into line with U.S. practice. But the amended claims retain the same type of unity as was present in the PCT application. The pending claims cover a set of compounds with formula I, processes for manufacturing these compounds, and the use of these compounds. Thus, the claims still meet the unity of invention requirement of 37 C.F.R. § 1.475(b)(3).

For these reasons, the Applicants respectfully request that the Examiner withdraw the restriction requirement.

The undersigned contacted the Examiner on February 8, 2006 and thanks the Examiner for a most helpful discussion. The undersigned and the Examiner discussed the claimed compounds and its "core structure". The Examiner and the undersigned also discussed the limited nature of the search and the Aldrich compound that the Examiner cited as prior art. The Examiner and the undersigned agreed to disagree about the importance of the Aldrich compound cited by the Examiner in the Restriction Requirement. The Examiner agreed that the

claimed compound with a chain containing a bi-substituted carbon (C<sub>a</sub>) which can be present 1, 2 or 3 times, a distinct carbon atom with a cyano moiety attached, and then a bi-substituted nitrogen atom does not result in too many different combinations for the Examiner to search. The Examiner also agreed that the pending claims meet the requirements of 37 C.F.R. § 1.475(b)(3). As such, the Examiner kindly agreed to withdraw the restriction requirement, and the Applicants are very grateful for the Examiner's decision.

The Applicants believe that all claims are in a condition for allowance and respectfully request that the Examiner issue the pending claims. If the Examiner disagrees, the Applicants request the Examiner to contact the undersigned to discuss the claims with the goal of agreeing on allowable subject matter.

The Commissioner is authorized to deduct any other fee necessary to keep this application pending, from Deposit Account 19-0134.

Respectfully submitted,

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